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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,447	03/15/2002	Kimiyuki Kobayashi	5259-000002	2970

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EXAMINER


BORISOV, IGOR N

ART UNIT PAPER NUMBER

3629

DATE MAILED: 07/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/088,447	<b>Applicant(s)</b> KOBAYASHI ET AL.	
	<b>Examiner</b> Igor Borissov	<b>Art Unit</b> 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Examiner's note*

Examiner suggests to substitute a word "an Internet" with "the Internet" in the Abstract, Specification on page 3 and in Claims 1 and 7. Also, on page one of the Specification, third sentence from the bottom, there is a misspelled phrase: "customers are dealt *with by*".

### *Claim Objections*

Claims 5-8 and 10 are objected to because of the following informalities:

Claims 7-8 and 10. The claims are not in compliance with MPEP 608.01(i), which states that a preamble should be separated from a body of a claim by a term "comprising".

Claims 5 and 6 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only, and cannot depend from any other multiple dependent claim. See MPEP § 608.01(n).

Accordingly, the claims 5 and 6 are not been further treated on the merits.

### *Double Patenting*

Applicant is advised that should claim 1 be found allowable, claim 9 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4 and 7-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Geerlings (US 5,956,693).

Geerlings teaches a computer system and method for merchant communication to customers, comprising:

Claim 1. A system including: means for managing customer registration data relating to the viewer terminal (C. 5, L. 66-67); means for managing content related to the Web site (C. 4, L. 67 - C. 5, L. 5); means for conducting a purchase over the Internet in real time environment (C. 5, L. 35-38) thereby inherently indicating validation of connection to the Internet by the viewer terminal; viewed contents monitoring means for managing Web site access histories (C. 2, L. 23-28); means for managing purchase history information of a customer (C. 4, L. 27-28); and viewer behavior collection and analysis means for collecting attribute information that is created by associating static information of the viewer terminal accessing the Web site with dynamic information relating to the behavior of the viewer (C. 3, L. 23-36).

Claim 2. A system including: means for managing customer registration data relating to the viewer terminal (C. 5, L. 66-67); means for managing content related to the Web site (C. 4, L. 67 - C. 5, L. 5); viewed contents monitoring means for managing

Web site access histories (C. 2, L. 23-28); means for managing purchase history information of a customer (C. 4, L. 27-28); and viewer behavior collection and analysis means for collecting attribute information that is created by associating static information of the viewer terminal accessing the Web site with dynamic information relating to the behavior of the viewer (C. 3, L. 23-36).

Claim 3. Said system as in claim 1. Information as to *retrieving from the attribute information the static information corresponding to the dynamic information that meets predetermined retrieval conditions, and retrieving from the attribute information the dynamic information corresponding to the static information that meets predetermined retrieval conditions* is non-functional language and given no patentable weight. Claims Directed to an Apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959).

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987). Thus the structural limitations of claim 3 are disclosed in Geerlings as described herein. Also as described the limitations of the claim do not distinguish the claimed apparatus from the prior art.

Claim 4. Said system as in claim 1, further including content supply means (C. 4, L. 67 - C. 5, L. 1). Information as to *delivering in accordance with the retrieval conditions surveys, electronic mail, advertisements, or predetermined content to the viewer terminals that correspond to the retrieved static or dynamic information* is non-functional language and given no patentable weight. Claims Directed to an Apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959).

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987). Thus the structural limitations of claim 4 are disclosed in Geerlings as described herein. Also as described the limitations of the claim do not distinguish the claimed apparatus from the prior art.

Claim 7. Said method, including: registering in advance customer registration data relating to the viewer terminal in advance (C. 5, L. 66-67); registering in advance content supply states relating to the Web site (C. 4, L. 67 - C. 5, L. 1); managing validation of information related to connections to the Internet (C. 5, L. 35-38); managing Web site access histories of the viewer terminal (C. 2, L. 23-28); managing purchase history information of the customer (C. 4, L. 27-28); and creating attribute information by associating static information of the viewer terminal accessing the Web site with dynamic information relating to the behavior of the viewer (C. 3, L. 23-36).

Claim 8. Said method, including: registering in advance customer registration data relating to the viewer terminal in advance (C. 5, L. 66-67); registering in advance content supply states relating to the Web site (C. 4, L. 67 - C. 5, L. 1); managing Web site access histories of the viewer terminal (C. 2, L. 23-28); and creating attribute information by associating static information of the viewer terminal accessing the Web site with dynamic information relating to the behavior of the viewer (C. 3, L. 23-36).

Claim 9. Said system, comprising: means for managing customer registration data relating to the viewer terminal (C. 5, L. 66-67); means for managing content related to the Web site (C. 4, L. 67 - C. 5, L. 5); means for conducting a purchase over the Internet in real time environment (C. 5, L. 35-38); thereby inherently indicating validation of connection to the Internet by the viewer terminal; viewed contents monitoring means for managing Web site access histories (C. 2, L. 23-28); means for managing purchase

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history information of a customer (C. 4, L. 27-28); and viewer behavior collection and analysis means for collecting attribute information that is created by associating static information of the viewer terminal accessing the Web site with dynamic information relating to the behavior of the viewer (C. 3, L. 23-36).

Claim 10. Said method, including: registering in advance customer registration data relating to the viewer terminal in advance (C. 5, L. 66-67); registering in advance content supply states relating to the Web site (C. 4, L. 67 - C. 5, L. 1); managing validation of information related to connections to the Internet (C. 5, L. 35-38); managing Web site access histories of the viewer terminal (C. 2, L. 23-28); managing purchase history information of the customer (C. 4, L. 27-28); and creating attribute information by associating static information of the viewer terminal accessing the Web site with dynamic information relating to the behavior of the viewer (C. 3, L. 23-36).

***Examiner's Note***

Examiner has cited particular columns and line numbers or figures in the references as applied to the claims for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

The following U.S. patents are cited to further show the best domestically patented prior art found by the examiner:

US 6,286,043 B1 to Cuomo et al. discloses a user profile management system for collecting information about user behavior in the presence of the dynamic page content.

US 6,178,407 B1 to Lotvin et al. discloses a system for monitoring user behavior in real-time for detecting unusual purchases.

US 5,838,314 to Neel et al. discloses a system for detecting "time-outs" of customers.

The following foreign patent is cited to show the best foreign prior art found by the examiner:

WO 99/12115 to Jermyn discloses a system for monitoring purchase history.

Examiner suggests the Applicant review these documents before submitting any amendment.

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 308-1113.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308- 2702.

Any response to this action should be mailed to:

***Commissioner of Patents and Trademarks***

***Washington D.C. 20231***

or faxed to:



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**(703) 305-7687** [Official communications; including After Final  
communications labeled "Box AF"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal  
Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.

Igor Borissov

Patent Examiner

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